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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/983,007	10/18/2001	Rocco Mertsching	V5305 JE/stt	7738

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Martin A. Farber
Suite 473
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New York, NY 10017

EXAMINER

SHAHER, RICKY D

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/983,007

Applicant(s)

MERTSCHING ET AL.

Examiner

Ricky D. Shafer

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aw

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 8-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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- I. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claim 9, drawn to a rearview mirror comprising a display and a distance measuring system, classified in class 340, subclass 435.
 - II. Claims 10 and 11, drawn to a rearview mirror comprising a liquid crystal display and a reflective film with particular details of the reflective film (i.e. one side of the film being virtually opaque while the other side of the film lets light through to illuminate the display), classified in class 349, subclass 193.
 - III. Claim 12, drawn to a rearview mirror comprising a transparent, self-luminous display, classified in class 40, subclass 541.
 - IV. Claim 13, drawn to a rearview mirror comprising a display, electronic components, control electronics and a housing, classified in class 359, subclass 871.
 - V. Claim 14, drawn to a rearview mirror comprising a pixel oriented liquid crystal display, a data processing unit, a light sensitive sensor and a reflective film, classified in class 349, subclass 195.
2. Claim 8 link(s) inventions I, II, III, IV and V. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claim 8. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims

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of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable.

In re Ziegler, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions V and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because of the omission of the particular details of reflective film having one side of the film being virtually opaque while the other side of the film lets light through to illuminate the display. The subcombination has separate utility such as a rear view mirror without a light sensitive sensor, pixel oriented liquid crystal display or data processing unit.

Inventions [I, II, IV] and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because of the omission of the particular details of the display being a transparent, self-

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luminous display. The subcombination has separate utility such as a rearview mirror without a distance measuring system, a reflective film or electronic components.

Inventions I, II and IV are related as subcombinations disclosed as usable together in a single combination or are patentably distinct each from the other as noted by their separate details. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each of the inventions I, II and IV have separate utility such as a rearview mirror with the separate details of the other invention(s). For example, the rearview mirror of group I has a separate utility as a rearview mirror without the reflective film of group II or the electronic components, control electronics and housing of group IV; the rearview mirror of group II has a separate utility as a rearview mirror without the distance measuring system of group I or the electronic components, control electronics and housing of group IV, and the rearview mirror of group IV has a separate utility as a rearview mirror without the distance measuring system of group I or the reflective film of group II. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification above, have acquired a separate status in the art because of their recognized divergent subject matter or the search required for one of the inventions is not coextensively required for any of the remaining inventions, as stated below. Therefore, restriction for examination purposes as indicated is proper.

The search required for invention II would further require a search in class 340, subclass 815.55 which would not be required for inventions I, III, IV and V.

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The search required for invention V would further require a search in class 345, subclass 207 which would not be required for inventions I, II, III and IV.

5. This application contains claims directed to the following patentably distinct species of the claimed invention:

- A). The species depicted by Fig. 3;
- B). The species depicted by Fig. 4; and
- C). The species depicted by Fig. 5.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species consistent with the elected invention mentioned above for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 8 is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to

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be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

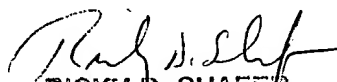
6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R.D. Shafer whose telephone number is (571) 272-2320.

RDS

03 April 2004


RICKY D. SHAFER
PATENT EXAMINER
ART UNIT 2872